

## **REMARKS**

Claims 52-71 are pending in the present application. In the First Office Action, claims 55-57, 60 and 61 were withdrawn from consideration as being directed to a non-elected invention. Claims 52-54, 58, 62, 65-67 and 69-71 were rejected. Claims 59, 64, and 68 were objected to as depending from a rejected base claim, but were indicated to be allowable if rewritten in independent form incorporating the limitations of the base claim and any intervening claims. In this response, claims 52, 54 and 65 have been amended and claims 72-77 have been added. Reconsideration of the present application as amended and including claims 52-77 in view of the following remarks is respectfully solicited.

Claims 52-53, 65-66 and 69-70 were rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,602,291 to Ray et al. Applicants' reserve the right to swear behind the filing date of Ray et al. in the present application or in any continuing application.

Assuming *arguendo* that Ray et al. is prior art, it does not disclose the elements in amended claim 52. Claim 52 recites "rehydrating the hydrogel core to expand the spacer in the disc space and position the upper and lower shells in rigid engagement with an adjacent vertebral endplate." Ray et al., on the other hand, discloses placing core 22 in a flexible jacket 24. When core 22 is hydrated, the spinal disc nucleus 20 generally conforms "to the anatomical shape of a general area or compartment of a disc space." See *e.g.*, col. 11, lines 23-27. Thus, jacket 24 is "a flexible tube" that surrounds the hydrogel core 22 and that is also conformable to the anatomical shape of the disc space when the

core is re-hydrated. *See* col. 7, lines 62-65. The flexible jacket thus does not rigidly engage the vertebral endplates, and Ray et al. therefore does not anticipate claim 52. Withdrawal of the rejection of claim 52 and claim 53 depending from it is respectfully requested.

Ray et al. also does not disclose the elements in amended claim 65. Claim 65 recites “hydrating the hydrogel core to expand the spacer in the disc space and rigidly engage the upper and lower shells with an adjacent vertebral endplate.” Ray et al., as discussed above with respect to claim 52, provides a flexible jacket 24 about core 22 so that the jacket conforms to the anatomical space when core 22 is hydrated. Accordingly, Ray et al. fails to disclose the features recited in claim 65, and withdrawal of the rejection of claim 65 and claims 66, 69 and 70 depending from it is respectfully requested.

Claims 54, 58, 62, 63, 67 and 71 were rejected under 35 USC 103(a) as being unpatentable over Ray et al. in view of U.S. Patent No. 6,171,339 to Houfburg et al. Amended claim 54 recites “expanding the reduced height implant in the disc space so that the upper shell and the lower shell rigidly engage adjacent vertebral endplates.” As discussed above with respect to claim 52, Ray et al. provides a flexible outer jacket to conform to the anatomical space in the spinal disc. Houfburg et al. fails to supply the teaching or motivation to modify Ray et al. to make the outer jacket rigidly engage the adjacent vertebral endplates. If the outer jacket in Ray et al. were modified to rigidly engage the adjacent vertebral endplates, then nucleus device 20 of Ray et al. would be rendered unsuitable since it would not be able to conform to the anatomy in the disc space. Accordingly, Ray et al. and Houfburg et al. are not properly combinable to render

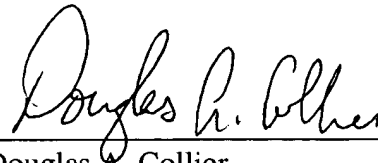
claim 54 obvious. Withdrawal of the rejection of claim 54 and its dependent claims 58 and 62 is respectfully requested.

Claim 63 depends indirectly from claim 52, and is therefore allowable at least for the reasons claim 52 is allowable as discussed above. Claims 67 and 71 depend directly or indirectly from claim 65, and are therefore allowable at least for the reasons claim 65 is allowable as discussed above. Accordingly withdrawal of the rejection of claims 67 and 71 is respectfully requested.

New claims 72-77 have been added in this response. Claims 72-73 depend from claim 52, claims 74-75 depend from claim 54, and claims 76-77 depend from claim 65. Claims 72-77 recite features not disclosed or suggested in Ray et al. and are also allowable.

In view of the foregoing amendments and remarks, claims 52-77 are in condition for allowance. A Notice of Allowance for the present application is hereby solicited. The Examiner is welcome to contact the undersigned to resolve any outstanding issues with regard to the present application.

Respectfully submitted:



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